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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re Application of:

GROUP ART UNIT: 3629

Bruce Archibald Short

Patent Application Serial No.: 09/987,772

Filed: November 15, 2001

Application Title: CONNECTION APPARATUS

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OFFICE OF PETITIONS

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(b)

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Dear Mr. Wood:

Further to our telephone conversation concerning the above-identified matter we obtained confirmation from the Applicant to address the formality deficiencies as noted in your letter dated April 30, 2003. The Applicant confirmed that the non-signing inventor was indeed presented with the application as set forth in initially filed declaration. A revised declaration is attached clarifying and confirming "the presentation" requirement, as well as addressing the remaining formality issues you noted.

The revised Declaration addresses specifically items numbered (1), (5) and (6) as listed in the initial denial of the petition.

Item number (1) requires proof that the non-signing inventor was presented with application and refused to sign the required declaration after being presented with documents. The revised declaration submitted herewith includes a clarification at paragraph 14 indicating that indeed the inventor refused after being presented with the application.

Additionally, items (5) and (6) have been addressed in the revised declaration at paragraph 16 wherein the declarant states that A. Ward Attachments is the true party with a proprietary interest (by way of assignment previously recorded) and irreparable damage will occur if the filing date of the application is not perfected.

In view of the revised declaration submitted herewith Applicant respectfully requests the Senior Petitions Attorney to reconsider the initial Petition and grant same.

Any questions concerning this matter may be directed to attorney Jeffrey H. Greger at 703-535-7069.

Respectfully submitted,

LOWE HAUPTMAN GILMAN & BERNER, LLP


Benjamin J. Hauptman
Registration No. 29,310

Date: October 29, 2003
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BJH:JHG

Att Docket 1519-031
formally 4059-19

STATUTORY DECLARATION

I, Simon Robert Ward, a New Zealand citizen of 16 Kenny Road, Remuera, Auckland, New Zealand, do solemnly and sincerely declare:

1. I am a Director of A Ward Attachments, a New Zealand company of 25 Roscommon Road, Wiri, Auckland, New Zealand (herein "my Company").

2. On 29 September 2000 my Company entered into a joint venture agreement ("the Agreement") with B.A. Short Limited (herein "Short"). The Agreement was entered into by both parties to commercialise and protect the intellectual property associated with a Quickhitch Connector. A copy of the Agreement is annexed as exhibit SW-1.

3. Clause 2.1(b) of the Agreement specified that Bruce Archibald Short should be listed as the applicant for all patent applications filed for the Quickhitch Connector. Under the terms of the Agreement, my Company was given the right to grant licenses for Connector (as detailed in clause 3.1 (a) (i) of the Agreement) and the responsibility of paying the costs associated with obtaining patent protection for the Quickhitch Connector (as per clause 2.2 of the Agreement).

4. On 15th May 2000 my Company and Short instigated the filing of a Patent Co-operation Treaty Application, No. PCT/NZ00/00073 for the Quickhitch Connector. Bruce Archibald Short was listed as the patent applicant for this PCT application.

5. In November 2001 I was advised by my *patent attorney* that I needed to file a number of national phase patent applications sourced from this PCT application to ultimately obtain patent rights for this invention. My patent attorney advised me that I had the option of filing national phase patent applications throughout the world sourced from this PCT application, provided such applications were made by 15 November 2001.

6. At this time I instructed my patent attorney to file national phase patent applications for the Quickhitch Connector in Australia and the United States of America.

7. Also at this time I discussed these national phase patent applications with Short. I advised Short of my intention to file national phase patent applications in Australia and the United States of America.

8. Short subsequently breached the terms of the Agreement and, on 21 May 2002 my Company issued notice of those breaches and terminated the Agreement.

9. Clause 6.5(b) of the Agreement contains provisions regarding any Company's rights upon termination, it specifically allows my company to act as Short's attorney and to assign the intellectual property rights involved to my Company.

10. I then executed the assignment of invention agreement prepared by my patent attorney to transfer the intellectual property rights associated with the Quickhitch Connector to my Company. A copy of this executed assignment is enclosed as exhibit SW-2.

11. On 15 November 2001 a national phase application sourced from Patent Co-operation Treaty Application, No. PCT/NZ00/00073 was made into the United States of America, this application received an application number 09/987,772.

12. On 20 September 2002 I met with Short and requested that, as inventor, he sign the Declaration and Power of Attorney form necessary to complete formalities on the US national phase filing and presented Short with the application and the Declaration and Power of Attorney.

13. My brother Peter Ward was in attendance at the meeting as a witness.

14. At this meeting Short indicated that he had would not sign the Declaration and Power of Attorney document after being presented with the application and the Declaration and Power of Attorney. Short stated that as he had no ownership of the patent application due to his prior breach he saw no benefit to himself or his company by signing.

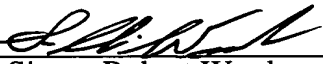
15. I told Short that although he had refused to sign the Declaration and Power of Attorney form I would be proceeding with this US national phase filing and would sign a Declaration stating Short's refusal to sign the Declaration and Power of Attorney form.

16. The filing date of the U.S. Application is necessary to preserve the rights in the currently pending U.S. Application. The acceptance by the USPTO of a suitable declaration or oath is required to perfect the filing date of the U.S. Application. Hence, without the ability to sign the requisite declaration on behalf of the recalcitrant inventor Short, the true party with the proprietary interest, namely, A.Ward Attachments Ltd., will suffer irreparable damage in the event the application filing date is not perfected and the application is deemed abandoned therefore.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent, and declares that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true

Declared at Auckland, New Zealand

by 
Simon Robert Ward
Director and Corporate Officer
of A. Ward Attachments, Ltd.

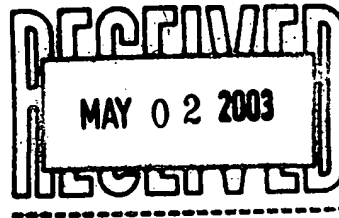
Date: 28/9/2003



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OFFICE OF PETITIONS

Re Application of
Bruce Archibald Short
Application No. 09/987,772
Filed: 15 November, 2001
Attorney Docket No. 4059/19

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(b)
:

This is in response to the petition filed on 15 January, 2003,
under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47: applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(b)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 15 November, 2001,
without an executed oath or declaration.

Accordingly, on 15 August, 2002, Initial Patent Examination
Division mailed a Notice To File Missing Parts of Nonprovisional
Application requiring the statutory basic filing fee, an executed
oath or declaration and a surcharge for their late filing.

In response, on 15 January, 2003, the present petition was filed,
accompanied by the statutory basic filing fee and the late filing
surcharge, and a declaration naming Bruce Archibald Short as the
sole inventor and signed by Simon Robert Ward, Director, A. Ward
Attachments, Ltd. on behalf of the non-signing inventor. A three
(3) month time extension in accordance with 37 CFR 1.136(a) was

also filed.

Petitioners assert that a copy of the declaration was personally presented to the non-signing inventor, but that the inventor refused to sign it.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (5) and (6).

As to item (1), petitioners have not presented proof that a copy of the application (specification, including claims, drawings, if any, and the Declaration) was sent or given to the non-signing inventor for review. The declaration of Simon Robert Ward does not state whether the application papers were presented to Short prior to the refusal. If the application as filed was presented to Short, any renewed petition should so state.

Alternatively, if the application is sent to the non-signing inventor, petitioner should submit a copy of the cover letter transmitting the application papers to the non-signing inventor at the inventor's last known address or details given in an affidavit or declaration of facts by a person with first-hand knowledge of the details.

If an inventor refuses in writing to sign the declaration, petitioners should submit that written refusal with any renewed petition. If an inventor refuses orally, then the person to whom that oral refusal was made must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (5), petitioners have not established that the Rule 1.47(b) applicant has sufficient proprietary interest in the

subject matter to justify the filing of the application.¹

Petitioners may establish proprietary interest by filing a copy of the employment agreement between the non-signing inventors and the Rule 1.47(b) applicant (company); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant; or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

In regards to item (6), petitioner must provide proof of irreparable damages in accordance with MPEP 409.03(g).

The Office is construing Simon Robert Ward's title as "Director" to mean he is a corporate officer of the assignee. If he is not a corporate officer, then proof of his authority to sign on behalf of the corporation must be submitted.²

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

¹MPEP 409.03(f).

²MPEP 409.03(b).